

REMARKS

This reply to the 6/2/05 Office Action does not amend any of the previously pending claims. The rejection set forth in the 6/2/05 Office Action is respectfully traversed.

The Office Action rejected all of the pending claims as being unpatentable over Matsumoto et al (hereinafter Matsumoto) US patent no. 6,526,285 in view of Schutzer et al (hereinafter Schutzer) US patent no. 5,920,848.

The Office Action recognized that Matsumoto failed to teach user defined category tags for tracking items. Office Action, p. 3. However, the Office Action states that Schutzer teaches a system and method for tracking financial transactions, and using a "learning agent to monitor user-defined category of expenses, such as restaurant expenses where the learning agent act[s] as a monitor". Office Action, pp. 3-4. The Office Action goes on to state that it would have been obvious to combine the teaching of Matsumoto and Schutzer because both teach a system to monitor financial data. Office Action, p. 4.

It is respectfully submitted, that the teaching of the Matsumoto and Schutzer teach two very different types of systems and methods, and that the teaching of these two references do not suggest any of the systems or methods recited the presently pending independent claims.

The Teaching of Matsumoto:

Matsumoto et al. teach a system where a device referred to as telephone apparatus 101 can be used to obtain information through a communication line 201 from a data server 301. Matsumoto et al. col. 25:11-48. The information can be retrieved from the server by specifying an industry division, or by specifying a company stock code. Matsumoto et al. col. 25:41-48. The information then obtained can be stored in a memory of the telephone apparatus 101, and if the memory does not have enough capacity for all of the requested information, then a first part of the information requested is transmitted to the telephone device, and then in response to a scroll operation by the user, a second part of the information requested to the telephone device, and this second information apparently displaces the first part of information in the memory of the device. Matsumoto et al. col. 26:1-27.

In another alternative in Matsumoto et al. contemplate a situation where the memory of the device has enough capacity to store more information than can be displayed on a display of

the device, and the user can scroll through the information stored in the memory, or it appears that a user might be able to select viewing of a specific stock which is stored in memory.

Matsumoto et al. col. 26:27-61. However, it is respectfully submitted that Matsumoto et al. does not appear to contain any teaching which suggests that a master list of data for items being tracked should be stored in the telephone device, and that one or more of the items being tracked will be supplied with multiple user defined category tags, such that the particular item would be displayed in multiple sublists, where the content of the sublists area controlled by the user defined category tags.

The Teaching of Schutzer:

Schutzer teaches a system where computerized intelligent agents are provided which facilitate the integration of networks performing financial transactions with computerized methods for accounting. See e.g. Schutzer, Abstract. Schutzer discusses providing users with the capability to perform a wide variety of financial transactions on-line, including bill payment and stock purchases, and incorporated with these operations are intelligent agents which can trace and monitor the financial transactions and expenses. Schutzer col. 4:27-40.

One aspect of the teaching of Schutzer specifically referred to in the Office Action (Office Action, p. 4) deals with various learning agents which can monitor user-defined categories of expenses such as restaurant expenses. Schutzer col. 12:46-60.

Given the teaching of Schutzer, and the teaching of Matsumoto, the question is then how do these two references, in combination teach the systems and methods of the presently pending claims. Indeed, it is respectfully submitted that it appears that there is nothing in Schutzer which would suggest that the category type information in Matsumoto should be replaced with accounting type category information as appears to be suggested by the Office Action.

The Combination of Matsumoto and Schutzer:

The Federal Circuit has addressed the requirements for a finding of obviousness on numerous occasions, and consistently the Federal Circuit has emphasized that there must be something in the prior art which suggests the combination of the various claim elements which are included in the claims. For example, in one relatively recent case the Federal Circuit stated in part as follow (emphasis added):

The patent examination process centers on prior art and the analysis thereof. **When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.** See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("**a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'**") (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("**Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.**"); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) ("**there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant**"); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, **the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.**"); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "**only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references**").

In Re Sang Su Lee, 277 F. 3d 1338, 134-43 (emphasis added) (Fed. Cir. 2002).

It is respectfully submitted that the system and method shown in the pending claims is very different than anything suggested by Matsumoto or Schutzer. Indeed using the combination of accounting categories which are provided by intelligent agents (Schutzer) in combination with the teaching of Matsumoto does not in any way suggest the elements recited in various pending claims as is discussed in more detail below.

The Present Invention:

An embodiment of the present invention provides for a very different operation and system than that described in the Matsumoto et al. reference. The present invention provides for a user selecting an overall data list of securities being tracked, and then this data list is held in a memory of the computing device, and then sublists are generated off the overall data list based on category tags which are provided for the securities being tracked. The operation of an embodiment herein provides for an effective and efficient solution for operating in an environment with limited transmission bandwidth and limited memory.

Indeed the system and method provide that a given item being tracked can actually have multiple categories. For example, consider a situation where items being tracked include 100 different securities. The information for these securities would be maintained in a data list with each of the different securities, and would include at least one user defined classification tag for each security, and at least one of the securities will have multiple different classification tags. The operation provides for displaying a sublist of the securities based on the classification tags. For example, the computing device could display a sublist of ten securities which have a classification tag of "hitek" and could then display a different sublist of, say for example, eight securities having a category tag of "medical". Further, given that at least one of the items being tracked has at least two category tags, for example, one of the securities could have the tags of both "hitek" and "medical", and such a security would be displayed both when the "hitek" category tag items are being displayed, and when the "medical" category tag items are displayed. Further, it should be noted that **these category tags are defined by the end user** of the handheld device. Thus, each user has powerful tool for creating their own customized watch lists, and this tool is also suited for making efficient use of limited communication bandwidth.

The Examiner's attention is respectfully drawn to **Figure 2 of the pending application**, which shows a list of items being tracked in the memory of a hand held device. The Pool of

Items table in Figure 2, shows that items number 7 and 8 actually correspond to the same security "S7", and then S7 is provided with two different watch list tags "L15" and "L1". As a result of having two different watch list tags, the security S7, is then displayed in two different watch lists (shown in Figure 2) as List L1 and List L15. Further, as illustrated in **Figures 7-9 of the present application**, the user of the hand held device, defines and controls the category tags for the items being tracked, and by controlling the category tags the user controls the content of the different sublists.

This operation of the present invention is very different than anything disclosed or suggested by Matsumoto, or Schutzer. The operation provided by the present invention offers a number of advantages in that a range of different displays of sublists can be provided, and each of the different sublists is generated off the same master data list, which is limited to a predetermined number of items to accommodate transmission bandwidth limitations, and the master data list is stored in the memory of the handheld device, and a single item can belong to multiple sublist groupings. The operation of the present invention thus allows a user the ability to identify a selected group of securities that they want track, and then the user can supply user defined category tags that allow the user to display customized sublists of tracked items, out of the master list of items.

Claim 1 and its Dependent Claims:

For ease of reference pending claim 1 is shown below, with emphasis added to certain elements of the claim:

1. (previously presented) A method for organizing a plurality of items which are being tracked in a personal organizer device of the type which is capable of exchanging information with a communications center, comprising the steps of:
 - maintaining a data list in the personal organizer device**, wherein the data list includes all of the plurality of items being tracked, wherein the plurality of items being tracked is **limited to a predetermined number of items**, and wherein maintaining the data list includes storing information received from the communications center in a memory of the personal organizer device, for each item being tracked;
 - including in the data list a user defined category tag for each of the plurality of items being tracked;**
 - displaying in a sublist associated with a designated category tag all of those items in the data list which have the designated category tag;
 - providing at least 2 category tags for at least a first one of the plurality of items being tracked;**
 - displaying the first one of the plurality of items being tracked in a first sublist associated with a first designated category tag;**
 - displaying the first one of the plurality of items being tracked in a second sublist associated with a second designated tag;**

receiving input from the user of the personal organizer device which defines the 2 category tags that are provided for the first one of the plurality of items being tracked; and
controlling the content of a plurality of different sublists based on the user defined category tags.

It is respectfully submitted that the above elements of claim 1 illustrate certain aspects of the claim 1 which are significant in distinguishing it from Matsumoto and Schutzer. For example, Matsumoto clearly contemplates tracking an unlimited number of items, and simply allowing a user to repeatedly make requests of transmissions of data (See e.g. Matsumoto et al., col. 26:1-25) whereas claim 1 expressly provides for limiting the number of items being tracked. Further, it does not appear that Schutzer provides for limiting tracking to a predetermined number of items. Additionally, the discussion of Matsumoto et al. provided above, shows that Matsumoto et al. do not teach providing user defined category tags, where one item, as a result of having multiple category tags, is displayed in two different sublists. Further, it is respectfully submitted that nothing in Schutzer appears to provide for this type of operation, where a predetermined number of items are provided with multiple tags. The operation as recited by claim 1 is distinct **and allows a user of the personal organizer device to be able to generate multiple customized sublists of information off of a single data list stored in a handheld device.**

The fact that the user controls the definition of the category tags, and determines which category tags are associated with particular items being tracked allows the user to control the content of different sublists. It is respectfully submitted that nothing in Matsumoto or Schutzer appears to suggest that user category tags should be provided, so that a user can create their own unique sublists, which are derived from a data list, which is limited to a predetermined number, stored in the personal organizer device. Thus, it is respectfully, submitted that claim 1 is patentable. Further it is respectfully, submitted that those claims depending from claim 1 are patentable for at least the same reasons as claim 1.

Claim 14 and its Dependent Claims:

For ease of reference pending claim 14 is shown below, with emphasis added to certain elements of the claim:

14. (previously presented) A system for tracking a plurality of items comprising:
- a personal organizer device in which information related to each of the plurality of the items being tracked is maintained in a data list, wherein the related information for each of the plurality of items includes a user defined classification tag, and wherein the data list and the user defined classification tags are stored in a memory of the personal organizer device; and
 - a central communications center which is capable of exchanging with the personal organizer device the related information of the items being tracked;
- wherein the personal organizer device operates to store information received from the central communications center for each of the items being tracked, and wherein in the personal organizer device operates to limit the number of items being tracked to a predetermined number;
- wherein the personal organizer device is capable of displaying a list of all of the plurality of items being tracked by an identifier and an associated user defined classification tag and displaying information received from the central communications center for all of the plurality of items being tracked; and is capable of displaying sublists of the plurality of the items being tracked organized by user defined classification tags along with information about the items received from the central communications center in the displayed sublists;
- wherein for at least a first item being tracked, a first user defined classification tag and a second user defined classification tag is provided, and wherein the first item is displayed in a first sublist which is associated with the first user defined classification tag, and the first item is displayed in a second sublist which is associated with the second user defined classification tag; and
- wherein the first user defined classification tag and the second user defined classification tag are determined by a user input through the personal organizer device, whereby the user controls which sublists the first item being tracked is displayed with, based on the user defined category tags the user provides for the first item being tracked.

It is respectfully submitted that the above elements of claim 14 illustrate certain aspects of the claim 14 which are significant in distinguishing it from Matsumoto and Schutzer. For example, Matsumoto clearly contemplates tracking an unlimited number of items, and simply allowing a user to repeatedly make requests of transmissions of data (See e.g. Matsumoto et al., col. 26:1-25); further Schutzer does not appear to provide for limiting the number of items being tracked in a personal organizer device, whereas claim 14 expressly provides for limiting the number of items being tracked.

The operation as recited by claim 14 is distinct **and provides an operation whereby limited bandwidth can be used optimally to allow a user of the personal organizer device to be able to generate multiple customized sublists of information off of a single data list stored in a handheld device.**

The fact that the user controls the definition of the category tags, and determines which category tags are associated with particular items being tracked allows the user to control the content of different sublists, which are derived from the single data list maintained in the personal organizer device. It is respectfully submitted that nothing in Matsumoto et al. appears

suggest that user category tags should be provided, so that a user can create their own unique sublists, which are derived from a data list stored in the personal organizer device. Thus, it is respectfully submitted that claim 14 is patentable. Further, it is respectfully submitted that those claims depending from claim 14 are patentable for at least the same reasons as claim 14.

Claim 38

For ease of reference pending claim 38 is shown below, with emphasis added to certain elements of the claim:

38. (previously presented) A method for organizing information for a plurality of securities which are being tracked in a hand held computing device of the type which is capable of exchanging information with a communications center, comprising:

- maintaining a data list in the hand held computing device, which includes information for all of the plurality of securities being tracked;
- transmitting information for all of the plurality of securities being tracked from the communication center to the hand held computing device over a wireless link**
- receiving input from the user of the hand held device which defines at least one category tag for each of the plurality of the securities being tracked;
- generating a plurality of different sublists wherein each sublist includes a different subset of the plurality of securities being tracked, wherein each sublist corresponds to a user defined category tag, whereby each security displayed in a particular sublist has a user defined category tag which corresponds to the user the user defined category tag of the particular sublist;
- for at least a first one of the securities being tracked providing at least two user defined category tags; and
- displaying in a sublist associated with a designated user defined category tag all of those securities in the data list which have the designated category tag, wherein the first security which has at least two different user defined category tags, will be displayed in at least two different sublists of securities based on the at least two user defined category tags provided for the first security.

The above elements of claim 38 illustrate certain aspects of the claim 38 which are significant in distinguishing it from Matsumoto and Schutzer. For example, Matsumoto clearly contemplates tracking an unlimited number of items, and simply allowing a user to repeatedly make requests of transmissions of data (See e.g. Matsumoto et al., col. 26:1-25). Thus, it would appear that the memory of Matsumoto et al would not include a data list for all of the items being tracked. Instead some information would initially be stored and then subsequently additional information would be received displacing the information originally stored. Further, even where Matsumoto et al is being used to for obtaining information for a relatively small number of items, as discussed above Matsumoto et al. do not appear to teach providing user defined

category tags, where one item, as a result of having multiple category tags, is displayed in two different sublists. Additionally, Schutzer does not appear to provide for maintaining a data list in a handheld device for securities being tracked, and for providing at least two user defined category tags for one of the securities being tracked, so that the security will be displayed in two different sublists. The operation as recited by claim 38 is distinct **and provides an operation whereby limited bandwidth can be used optimally to allow a user of the personal organizer device to be able to generate multiple user defined sublists of information off of a single data list stored in a handheld device.**

Further, the fact that the user controls the definition of the category tags, and determines which category tags are associated with particular items being tracked allows the user to control the content of different sublists, which are derived from the single data list maintained in the personal organizer device. It is respectfully submitted that nothing in Matsumoto or Schutzer appear to suggest that user category tags should be provided, so that a user can create their own unique sublists, which are derived from a large data list stored in the personal organizer device. Thus, it is respectfully, submitted that claim 38 is patentable.

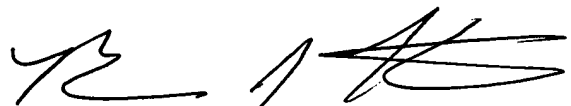
CONCLUSION

For the reasons set forth above, it is believed that all claims present in this application are patentably distinguished over the references. Therefore, reconsideration is respectfully requested, and it is requested that this application be passed to allowance.

Respectfully submitted,

STALLMAN & POLLOCK LLP

Dated: July 21, 2005

By: 
Brian J. Keating
Reg. No. 39,520

Attorneys for Applicant(s)